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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,327	01/20/2000	Ryan S. Holmqvist	HOLMQVIST-1	4272
27964	7590	01/14/2004	EXAMINER HOLLOWAY III, EDWIN C	
HITT GAINES P.C. P.O. BOX 832570 RICHARDSON, TX 75083			ART UNIT 2635	PAPER NUMBER 6

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/488,327

Applicant(s)

HOLMQVIST, RYAN S.

Examiner

Edwin C. Holloway, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

***Examiner's Response***

1. In response to applicant's amendment filed 9-30-03, all the amendments to the specification and claims have been entered. The examiner has considered the new presentation of claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "call-back number identified from a priority list" in claims 1, 8 and 15 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-21 are rejected under 35 U.S.C. 112, first

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paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1, 8 and 15 have been amended to add "wherein said party identification information includes a call-back number identified from a priority list." This limitation is only recited in the specification as an alternative in the summary of the invention at page 4 lines 1-2 and in the concluding summary at page 18 lines 5-6. The specification lacks a description of how to make and/or use this limitation in the invention described between the summaries. There is no indication or suggestion of where to include the priority list in the invention illustrated in figs. 1-2. It is not clear what identifies the number from the list.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-3, 5-10, 12-17 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes (US 5668852) in combination with Arledge (US 5561703) or Kraus (US 5692038).

Regarding claims 1, 8 and 15 Holmes discloses a paging system, method and network infrastructure with auxiliary

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information collector including decoding equipment 24 for extracting caller associated information (CAI) datum such as caller ID, and auxiliary information transmitter that automatically transmits the CAI to a pager. Answering equipment 20, decoding equipment 24 and messaging equipment 26 function as a call center to handle incoming calls. See col. 3 line 25- col. 4 line 41 and figs. 1-2. Holmes differs from the claims by not expressly disclosing "wherein said party identification information includes a call-back number identified from a priority list."

Arledge and Kraus disclose analogous art system with a priority list of call-back numbers that allows limiting pages to priority or urgent calls to reduce interruptions. The priority codes in Kraus may also be used to identify the source. See the abstract and cols. 11, 17-22 and 27-29 of Kraus. See the abstract, col. 2 and cols. 6-8.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Holmes the limitation of "wherein said party identification information includes a call-back number identified from a priority list" in claims 1, 8 and 15 because Arledge and Kraus disclose analogous art system with a priority list of call-back numbers that allows limiting pages to priority or urgent calls

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to reduce interruptions. If the paging notification is limited to the priority list, the transmitted call back number must be identified in the priority list. This is further suggested by Kraus disclosing that priority codes may also be used to identify the source.

Regarding claims 2, 9, and 16 caller ID information is received from an ANI transmission of the local telephone switching system or PSTN. Regarding claims 3, 10 and 17 prompting the paging party for CAI is in col. 4 lines 35-41. Regarding claims 5, 12 and 19 the CAI includes names, addresses and telephone numbers in col. 2 lines 34-38. Also, telephone numbers include area code and local exchange corresponding to location. Regarding claims 6, 13 and 20 a database is included in col. 4 lines 15-26 and col. 4 line 56 - col. 5 line 7. Buffer 32 may also be considered a database. Regarding claims 7, 14 and 21 an alphanumeric page is specified in col. 1 line 61-67.

7. Claims 4, 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes (US 5668852) in combination with Arledge (US 5561703) or Kraus (US 5692038) as applied above in combination with Chen (US 5592531), Aas (US 5940740) or Taskett (US 6044247).

Chen (col. 3 lines 1-35), Aas (col. 3 line 60 -col. 4 line

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19) and Taskett (col. 4 lines 12-42) disclose analogous art paging systems, methods and infrastructures with voice recognition of input from a paging party as an alternative to input by DTMF from dialing or ANI so that the paging party simply speaks the desired information to the call controller. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the voice recognition of Chen, Aas or Taskett in system, method and infrastructure of Holmes applied above as an obvious alternative to the inputs of Holmes, because Holmes includes voice instructions in col. 1 lines 35-40 and because this would allow input by simply speaking the information by the paging party.

8. Claims 5, 12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes (US 5668852) in combination with Arledge (US 5561703) or Kraus (US 5692038) as applied above in combination with Taskett (US 6044247) or Henderson (US 6278862).

Taskett (col. 8 lines 7-29 and fig. 6B) and Henderson (col. 12 lines 1-15 and fig. 6) disclose analogous art paging systems, methods and infrastructures with caller information including location. If location is given weight and not clear from Holes, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the location information of Taskett or Henderson in the system,

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method and infrastructure of Holmes applied above as a caller ID suggested by the various CAI of Holmes.

9. Claims 6, 13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes (US 5668852) in combination with Arledge (US 5561703) or Kraus (US 5692038) as applied above in combination with Taskett (US 6044247) or Laufmann (US 6192218).

Taskett (col. 4 lines 42-56 and fig. 1) Laufmann (abstract) disclose analogous art paging systems, methods and infrastructures with caller information stored in a database associated with the call controller or center. If it is not clear that the database of Holmes is associated with the call center, then it would have been obvious to one of ordinary skill in the art at the time the invention was made to have associated or located the database of Holmes at the call center as disclosed in Taskett or Laufmann for storing calling party information associated with the paging system.

10. Claims 7, 14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes (US 5668852) in combination with Arledge (US 5561703) or Kraus (US 5692038) as applied above in combination with Pepe (US 5742668).

Pepe disclose analogous art paging system, method and infrastructure with various mobile communication subscribers disclosed in col. 5 lines 18-30 and shown in fig. 1 as pager 34,



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cellular phone 32 or personal digital assistant (PDA) 30. If cellular phone and PDA are given weight, then it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the PDA and cellular phone of Pepe in the system, method and infrastructure of Holmes applied above as variations of the alphanumeric pager mobile subscriber of Holmes.

***Response to Arguments***

11. Applicant's arguments filed 9-30-03 with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Silverman (US 6035031) and Letellier (US 6154530) disclose call back lists with priority.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this

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action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### **CONTACT INFORMATION**


Any inquiry of a general nature or relating to the status of this application should be directed to the Technology center 2600 receptionist whose telephone number is (703) 305-4700.

Facsimile submissions may be sent via fax number (703) 872-9306 to customer service for entry by technical support staff. Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (703) 305-4818. The examiner can normally be reached on M-F (8:30:-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (703) 305-4704.

EH

1/11/04

  
EDWIN C. HOLLOWAY, III  
PRIMARY EXAMINER  
ART UNIT 2635